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VEDDER PRICE P.C. 222 N. LASALLE STREET CHICAGO, IL 60601				YALEW, FIKREMARIAM A
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/748,523	CHIVIENDACZ ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Fikremariam Yalew	2436	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 21 January 2009.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-4,6-9,11-23 and 25-57 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-4,6-9,11-23 and 25-57 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. The office action is in reply to an amendment filed on 01/21/2009. Claims 5, 10, 24 were previously cancelled. Claims 6, 8-9, 22, 39, have been amended. Claims 1-4, 6-9, 11-23, 25-57 are pending.
2. The examiner withdraws the claim objection based on the applicant claim amendment.

### ***Response to Arguments***

3. The examiner withdraws the previous 35 USC 101 rejection regarding to claim 6, based on the applicant claim amendment. However, the examiner maintains the previous 35 USC 101 rejection regarding to claims 36-38 and 43-44 because the applicant argument is not persuasive. See the 35 USC 101 rejections below.
4. The examiner also maintains 35 USC 112 first rejections because the applicant argument is not persuasive and Fig 1 does not explicitly show a translucent identification member without a corresponding filtering pattern thereon. See the 35 USC 112 first rejections below.
5. Applicant's arguments with respect to claim 1-4, 6-9, 11-23, 25-57 have been considered but are not persuasive. The applicant argued that the prior art do not suggest or teach "assigning identification information to one or more obscure user identifiers and providing the identification information on the translucent identification member. The examiner disagree and points out the prior art teach assigning identification information to one or more obscure user identifiers(See col.1 lines 44-47(i.e., predetermined sequence may be a personal identification number)) and providing the identification information on the translucent identification member(See col.2 lines 45-47 and col.1 lines 58-61(i.e., the substrate be transparent, frosted, colored or opaque and a recording means comprises a paper sheet member)). Also applicant's argued that there is no

suggestion to combine the references of Oksman and Goede, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, .It would modify in order to achieve the predictable result and enhance security of the system.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 36-38,43-44 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

8. Claims 36, 43 are directed an apparatus for securely providing identification information. Claims 36, 43 are rejected under 35 U.S.C. 101 because the claimed invention directed to non-statutory subject matter. Claim 36, 43 are an apparatus claim without any structural component and consists solely of language that is implemented with only software (See 0032). Claims 36, 43 do not provide any functional interrelationship to any software and hardware structural components to provide certain function that is processed by a computer. Claims 37-38 and 44 are depending on claims 36, 43 and rejects on the same rational.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 1,6,57 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to mention or teach the translucent identification member without a corresponding filtering pattern thereon.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1-4,6-9,22-28,52-57 are rejected under 35 U.S.C. 102(b) as being anticipated by Goede (US Patent No 5,246,375).

13. As per claims 1,6,57: Goede discloses a method/apparatus for making a secure identification information member for a user comprising: generating one or more obscured user identifiers (See col 3 lines 25-29); and generating a translucent identification member having a translucent area that includes the one or more obscured user identifiers (See col 2 lines 45-47(i.e., the substrate be transparent,frosted,colored or opaque)) the translucent identification member without corresponding filtering pattern thereon(See col 1 lines 57-64(i.e., paper sheet

member)); assigning identification information to the one or more obscured user identifiers(See col 1 lines 44-47(i.e., predetermined sequence such as personal identification number); storing the identification information and associated one or more obscured user identifiers(See col 1 lines 50-54(i.e., recoding the predetermined sequence); and providing the identification information on the translucent identification member(See col 2 lines 45-47,col 1 lines 58-61(i.e., the substrate be transparent, frosted,colored or opaque).

14. As per claims 2,7: Goede discloses the method wherein generating the one or more obscured user identifiers includes: obtaining user specific information associated with the user (See col 3 lines 57-62); and combining the user specific information with other information to produce the one or more obscured user identifiers (See col 1 lines 58-61, col 2 lines 45-47).

15. As per claims 3, 8: Goede discloses the method wherein generating the one or more obscured user identifiers includes: obtaining user specific information associated with the user (See col 1 lines 44-47); and using the user specific information to produce the one or more obscured user identifiers (See col 2 lines 50-61).

16. As per claims 4,9: Goede discloses the method of wherein generating the one or more obscured user identifiers includes: generating the one or more obscured user identifiers independent of any user specific information (See col 1 lines 58-61, col 2 lines 45-47).

17. As per claim 22: Goede disclose a method for associating secure identification information with a user comprising: receiving a request from a user for one or more obscured user identifiers (See col 3 lines 25-29 ); recording a link between the user and the identification information associated with the one or more obscured user identifiers(See col 1 lines 47-56); and wherein the one or more obscured user identifiers are on a translucent identification member,

sized to be smaller than a display, that is sent to the user(See col 2 lines 45-47,col 1 lines 58-61 and Fig 4a).

18. As per claim 23: Goede discloses the method including: providing the one or more obscured user identifiers to the user (See col 1 lines 44-47).

19. As per claim 25: Goede discloses the method wherein the one or more obscured user identifiers are sent to a third party to be placed on a translucent identification member for the user (See col 2 lines 45-47, col 1 lines 58-61).

20. As per claim 26: Goede discloses the method wherein the one or more obscured user identifiers are sent to the user for placement on a translucent identification member (See col 3 lines 11-29).

21. As per claim 27: Goede discloses the method wherein the one or more obscured user identifiers are selected from a pre-existing pool of obscured user identifiers (See col 2 lines 54-67).

22. As per claim 28: Goede discloses the method the request from the user includes user specific information and wherein the user specific information is combined with other information to produce the one or more obscured user identifiers(See col 2 lines 45-47,col 1 lines 58-61)

24. As per claim 52: Goede discloses a transaction card comprising: a first portion at least containing transaction card identification information (See col 2 lines 45-47,col 1 lines 58-61 ); a second portion containing a translucent identification member having a translucent area that includes one or more obscured user identifiers(See col 2 lines 45-47,col 1 lines 58-61).

25. As per claim 53: Goede disclose the transaction card wherein the second portion containing the translucent identification member includes an attached translucent identification member (See col 1 lines 57-64).

26. As per claim 54: Goede disclose the transaction card wherein the second portion containing the translucent identification member includes an open area with a connecting structure configured to receive and hold the translucent identification member (See col 1 lines 57-64 and Fig 5).

27. As per claim 55: Goede disclose the transaction card wherein the translucent identification member is configured to overlay at least a portion of a display screen (See col 1 lines 57-64 and Fig 5).

28. As per claim 56: Goede disclose the transaction card wherein the translucent identification member includes a translucent area having an information pattern representing a plurality of different identifiers for use at a plurality of different times and is configured to overlay at least a portion of a display screen (See col 4 lines 10-29).

29. **Claims 11-20, 29-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oksman et al (hereinafter referred as Oksman) US Patent No 5,233,436 in view of Goede (US Patent No 5,246,375).**

30. As per claim 11: Oksman discloses a method for securely providing identification information comprising: sending a visual filtering pattern to a display device wherein the filtering pattern is defined such that when the visual filtering pattern is visually combined with one or more obscured user identifiers located on a translucent identification member (See col 4 lines 14-19,col 4 lines 32-41,col 5 lines 8-15), a designated one of the one or more identifiers is

visually revealed (col 3 lines 62-65,col 4 lines 17-19); and receiving data representing the visually revealed identifier(col 5 lines 5-15).

Oksamn does not explicitly teach obscured user identifiers located on a translucent identification member and identification member sized to be smaller than a display.

However Goede obscured user identifiers located on a translucent identification member(See col 2 lines 45-47,col 1 lines 58-61); identification member sized to be smaller than a display(See Fig 4(a) steps 12,18).

Therefore it would have been obvious to one having ordinary skill in the art at that time the invention was made to employ the teachings method of Goede within Oksamn in order to enhance security of the system.

31. As per claim 12: the combination of Oksman and Goede disclose the method including sending the received data representing the visually revealed identifier to an authentication apparatus (See Oksman col 5 lines 5-15).

32. As per claim 13: the combination of Oksman and Goede discloses the method wherein the data representing the visually revealed identifier is received using a device other than the device on which the visual filtering pattern is displayed (See Oksman col 3 lines 63-65 and col 4 lines 14-18).

33. As per claims 14,29: Oksman discloses a method/system for securely providing identification information comprising: receiving user identification information (col 5 lines 7-15); using the user identification information to identify a translucent identification member and one or more obscured user identifiers known to have been associated with such user (col 4 lines 14-19,col 4 lines 32-41,col 5 lines 8-15); generating a visual filtering pattern that when combined

with the one more obscured user identifiers on the identified translucent identification member will reveal the selected particular obscured user identifier from among the obscured user identifiers(col 4 lines 14-19,col 4 lines 32-41,col 5 lines 8-15); transmitting the visual filtering pattern and requesting entry of the revealed identifier(See col 4 lines 52-68,col 4 lines 17-19); and receiving data representing the revealed identifier(See col 5 lines 8-15).

Oksman does not explicitly teach translucent identification member (See col 2 lines 45-47,col 1 lines 58-61); selecting from the one or more obscured user identifiers a particular obscured user identifier to be used as a second factor of authentication for the user associated with the received user identification information(See col 2 lines 45-47,col 1 lines 58-61) and sized to be smaller than a display that comprises a plurality of obscured user identifiers(See Fig 4(a) steps 12,18).

However Goede teaches transduction member; selecting from the one or more obscured user identifiers a particular obscured user identifier to be used as a second factor of authentication for the user associated with the received user identification information and sized to be smaller than a display that comprises a plurality of obscured user identifiers ;transduction member.

Therefore it would have been obvious to one having ordinary skill in the art at that time the invention was made to employ the teachings method of Goede within Oksamn method in order to enhance security of the system.

34. As per claims 15,30:the combination of Oksman-Goede disclose the method including examining the received data representing the visually revealed identifier to determine if it matches an expected value (See Oksman col 5 lines 7-15).

35. As per claims 16,31: the combination of Oksman-Goede disclose the method wherein the expected value has been determined before receipt of the received data representing the visually revealed identifier ( See Oksman col 4 lines 13-20).

36. As per claims 17,32: the combination of Oksman-Goede disclose the method wherein the expected value is determined after receipt of the received data representing the visually revealed identifier (See Oksman col 4 lines 13-20).

37. As per claims 18,33: the combination of Oksman-Goede disclose the method including granting a right to the user if the received data representing the visually revealed identifier matches the expected value (See Oksman col 5 lines 5-15).

38. As per claims 19,34: the combination of Oksman-Goede disclose the method including sending the received data representing the visually revealed identifier to an authentication apparatus (See Oksman col 6 lines 6-12,col 5 lines 5-15).

39. As per claims 20,35: the combination of Oksman-Goede disclose the method including receiving a reply from the authentication apparatus and granting a right to the user if the authentication apparatus indicates that a match with the expected value occurred (See Oksman col 5 lines 7-15).

40. As per claims 21: the combination of Oksman-Goede disclose the method wherein the step of using the user identification information includes checking if the translucent identification member is valid based on a list of invalid translucent identification members (See Oksman col 5 lines 7-15).

41. As per claim 36: Oksman discloses an apparatus for securely providing identification information comprising: a translucent identification member authenticator operative to receive

user data representing a revealed identifier in response to overlaying a translucent identification member on a display (See Oksman col 4 lines 14-41,col 5 lines 8-15); and operative to compare the received data with a corresponding expected revealed identifier to determine whether proper authentication of the user is appropriate (see Oksman col 5 lines 5-15).

Oksman does not explicitly teach a translucent identification member; sized to be smaller than a display, that is sent to the user.

However Goede teaches a translucent identification member (See col 2 lines 45-47,col 1 lines 58-61);sized to be smaller than a display, that is sent to the user(See Fig 4(a) steps 12,18).

Therefore it would have been obvious to one having ordinary skill in the art at that time the invention was made to employ the teachings method of Goede within Oksamn inorder to enhance security of the system

42. As per claim 37: Oksman and Goede disclose the apparatus wherein the translucent identification member authenticator determines the expected revealed identifier prior to the receipt of the received data corresponding to the revealed identifier (See Oksman col 5 lines 5-15).

43. As per claim 38: Oksman and Goede disclose the apparatus wherein the translucent identification member authenticator determines the expected revealed identifier after the receipt of the received data corresponding to the revealed identifier (See Oksman col 5 lines 5-15).

44. As per claim 39: Oksman discloses an apparatus for associating secure identification information with a user comprising: a circuit operative to receive a request from a user for a translucent identification member (See Oksman col 4 lines 14-41 col 5 lines 27-36,col 5 lines 43-

48); and operative to record a link between the user and the identification information associated with the one or more obscured user identifiers (See Oksamn col 6 lines 6-12).

Oksman does not explicitly teach translucent identification member; sized to be smaller than a display, that is sent to the user.

However Goede teaches translucent identification member(See col 2 lines 45-47,col 1 lines 58-61); sized to be smaller than a display, that is sent to the user(See Fig 4(a) steps 12,18).

Therefore it would have been obvious to one having ordinary skill in the art at that time the invention was made to employ the teachings method of Goede within Oksamn in order to enhance security of the system.

45. As per claim 40: Oksman and Goede disclose the apparatus wherein the circuit is operative to select the one or more obscured user identifiers are selected from a pre-existing pool of one or more obscured user identifiers (See Oksman col 6 lines 6-12).

46. As per claim 41-42: Oksman and Goede the circuit is operative to request information from the user that includes user specific information and wherein the user specific information is combined with other information to produce the one or more obscured user identifiers(See col 2 lines 45-47,col 1 lines 58-61).

47. As per claim 43: Oksman discloses an apparatus for securely providing identification information comprising: a visual filtering pattern generator operative to generate a visual filtering pattern based on data identifying a translucent identification member that has a translucent area that includes one or more obscured user identifiers such that when the visual filtering pattern is visually combined with the one or more obscured user identifiers on the translucent identification member (col 4 lines 14-19,col 4 lines 32-41 and col 5 lines 8-15), a

designated one of the one or more obscured user identifiers is revealed (col 4 lines 14-19, col 4 lines 32-41).

Oksman does not explicitly teach translucent identification member; sized to be smaller than a display, that is sent to the user.

However Goede teach translucent identification member (See col 2 lines 45-47, col 1 lines 58-61): sized to be smaller than a display, that is sent to the user (See Fig 4(a) steps 12,18).

Therefore it would have been obvious to one having ordinary skill in the art at that time the invention was made to employ the teachings method of Goede within Oksamn in order to enhance security of the system

48. As per claim 44: Oksman and Goede disclose the apparatus including a translucent identification member authenticator operative to receive data representing the revealed identifier in response to overlaying the translucent identification member with one or more obscured user identifiers on a display (See Oksman col 4 lines 14-19, col 4 lines 32-41, col 5 lines 5-15,); and to compare the received data with a corresponding expected identifier to determine whether proper authentication of the recipient is appropriate (See Oksman col 5 lines 8-15).

49. As per claim 45: Oksman discloses a method for securely providing identification information comprising: displaying a visual filtering pattern defined such that when the visual filtering pattern is combined with one or more obscured user identifiers located on a translucent identification member, a designated one of the one or more visual identifiers is revealed (col 4 lines 14-18, col 4 lines 16-25); and receiving input data representing the visually revealed identifier (col 4 lines 14-18, col 5 lines 5-15).

Oksman does not explicitly teach translucent identification member (See col 2 lines 45-47,col 1 lines 58-61)sized to be smaller than a display, that is sent to the user(See Fig 4(a) steps 12,18).

However Goede teaches translucent identification member (See col 2 lines 45-47,col 1 lines 58-61)sized to be smaller than a display, that is sent to the user(See Fig 4(a) steps 12,18).

Therefore it would have been obvious to one having ordinary skill in the art at that time the invention was made to employ the teachings method of Goede within Oksamn in order to enhance security of the system.

50. As per claim 46: Oksman and Goede disclose the method wherein displaying the visual filtering pattern includes indicating an overlay area on the display for overlaying the translucent identification member (See Oksman col 4 lines 16-25).

51. As per claim 47: Oksman and Goede disclose the method including the step of transmitting the received input data representing the visually revealed identifier (See Oksamn col 4 lines 16-25).

52. As per claim 48: Oksman and Goede disclose the method wherein the received input data is received on a device other than the device that is used to display the visual filtering pattern (See Oksman col 5 lines 8-15).

53. As per claim 49: Oksman and Goede disclose a secure identification information member comprising: a translucent area having an information pattern representing one or more identifiers configured to overlay a portion of a display screen (See Oksman col 4 lines 14-19,col 4 lines 32-41 and col. 5 lines 8-15).

54. As per claim 50: Oksman and Goede disclose the secure identification information member including additional information thereon relating to at least one specific use of the member (See Oksman col. 4 lines 14-19,col 4 lines 32-41 and col. 5 lines 8-15).

55. As per claim 51: Oksman and Goede disclose the secure identification information member wherein the additional information represents information for use in at least one of: voting, banking, online transaction and membership (See Oksman col. 4 lines 14-19,col 4 lines 32-41 and col. 5 lines 8-15).

***Conclusion***

**56. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fikremariam Yalew whose telephone number is 5712723852. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Moazzami Nasser can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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2436